

second drive shaft 32, bearings, a propeller 68, a hydraulic ram 74 with a piston rod 78, skeg 77, a cavitation plate 66, and steering means 48 but did not disclose a spring return hydraulic ram. It was also thought by the Examiner that Christiaens et al disclosed a spring return hydraulic ram as disclosed by Applicants and that it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the hydraulic ram of Adams et al. as a spring return hydraulic ram as taught by Christiaens et al. for to ensure that the piston always returns to the fully retracted position.

In response to the rejection of Claims 1-4, 8-13, 19 and 20 under 35 U.S.C. § 103(a), Applicants respectfully suggest that the Claims are not unpatentable over Adams et al (US 3,993,116) in view of Christiaens et al. (US 6,418,717). The hydraulic cylinder 74 of Adams et al., as shown in Adams et al. Fig. 2 and described at Col. 3, lines 3-17, is intended for “maintaining the piston on the piston rod 78 so as to position the propeller 68 at the desired angle” From this description it can be seen that the cylinder 74 of Adams et al is intended to allow the user to fix the position the propeller 68 at desired angle in a selected range, though as admitted by Adams et al, not always at the optimum angle for driving the boat. (See Adams et al., Col. 3, lines 11-17)

The Merriam-Webster Dictionary, © 2000 Zane Publishing Company, Inc. and Merriam-Webster, Inc., defines maintain as “to keep in an existing state”. Because the cylinder 74 of Adams et al is intended to maintain (keep) a desired position of the propeller 68 during operation of the boat, Adams et al teaches away from the use of the spring return hydraulic cylinder proposed by Applicants because such a cylinder

allows the propeller shaft and propeller to continually swing upward and downward during operation as obstacles are encountered. The function of Applicants' spring return hydraulic cylinder is thus contrary to the intent and teachings of the cylinder 74 of Adams et al.

Further, a close look at the spring return hydraulic ram 10, as shown in Fig. 1 and Fig. 2 and described in Christiaens et al at Col. 2, lines 12 to 23, will also show the piston 13 is on the spring side of the cylinder 10. This position of spring 32 and piston 13 allows the piston 13 to "always return to the fully retracted position". In Applicants' invention, as shown in Applicants' Fig. 6 and as described in Applicants' specification on page 8, line 16 to page 9, line 16, the spring is above the piston 54 with the piston rod 52 is on the fluid side of the cylinder. Consequently, as shown and described by Applicants, the piston rod returns to its fully extended position so as to allow the shaft log 22 and propeller 38 to be lowered into the water. From this review it can be seen that use of the hydraulic cylinder disclosed by Christiaens et al. would teach away from its combination with Adams et al. to disclose a boat drive unit having a spring return hydraulic cylinder to maintain the position of the cylinder rod in an extended position and thus keep the propeller shaft in its operating position as described by Applicants.

It is respectfully suggested that there can be no *prima facie* obvious rejection under 35 U.S.C. § 103(a) when, as in this case, the cited reference teaches away from the claimed features. As a consequence, because the cylinder 74 of Adams et al. is to maintain the position of the propeller, Adams et al. and because the cylinder 10 of Christiaens et al is intended to retract, not extend, the piston these references cannot

be properly used in combination to support such a rejection.

It should also be noted that the function of the cylinder 74 of Adams et al. would be destroyed if the cylinder 74 did not maintain the position of the propeller as described in and thought desirable by Adams et al. and substituting a spring return cylinder would not achieve the effect and benefit of maintaining the propeller in place that was disclosed. It is respectfully suggested that in cases where the cited reference must be modified, one of ordinary skill in the art would not find reason to make the proposed modification and that rejection of Applicants' claims on the basis of obviousness under 35 U.S.C. § 103(a) cannot be properly made.

Finally, it should also be noted that the problems associated with maintaining the position of propeller as described by Adams et al. at Col. 3, lines 3-17, are substantially the same problems that Applicants are attempting to address with his invention. The cylinder 74 of Adams et al is essentially a jack that lifts and holds the propeller up above obstructions. See Applicants' specification at page 2, lines 3-5. It is respectfully suggested that when a cited reference does not suggest the problem or the purpose of Applicants' claimed invention, such a reference is not sufficient to support a prima facie obviousness rejection under §103. *Eibel Process Co. v. Minnesota and Ontario Paper Co.*, 261 US 45 (1923).

Also note that as a matter of form, Claim 3 and Claim 12 have been amended to remove a typographical error. The original claims had the phrase -- wherein said further comprising --. These claims have been amended as shown on the Listing of Claims to delete -- wherein said -- from the claim language. The scope of the claims has not been changed.

Considering the foregoing, it is respectfully requested that the rejection of Claims 1-4, 8-13, 19 and 20 under 35 U.S.C. 103(a) as being unpatentable over a proposed combination of Adams et al (US 3,993,116) and Christiaens et al. (US 6,418,717) be withdrawn and the these claims be passed to issue.

2. Claim 5 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of Applicants' invention. Claim 5 was noted to depend upon itself. Applicants have now amended Claim 5 to depend upon Claim 2 and it now has all of the limitations of Claim 2 and its base claim, Claim 1. Considering this amendment, it is respectfully requested that the rejection of Claim 5 under 35 U.S.C. § 112, second paragraph, be withdrawn.

Claim 5 was rejected under 35 U.S.C. 103(a) as being unpatentable over a proposed combination of Adams et al (US 3,993,116) and Christiaens et al. (US 6,418,717) as applied to Claim 1 and in further view of Martin (5,249,993). Martin was thought to disclose a weedless propeller, which was not disclosed in Adams et al. The Examiner thought that it would be obvious to a person of ordinary skill in the art at the time the invention was made to form the propeller of Adams et al as a weedless propeller to prevent stalling.

Applicants' respectfully suggest that all of the limitations of claim 5 must be considered and that, for the reasons noted above, Adams et al in view of Christiaens et al. are not properly combinable as references and do not suggest or teach all of the limitations of claim 5. It is also suggested that it would be incorrect to focus the §103 inquiry on a particular limitation or on the "gist" of the invention relative to prior art.

The claims must be read as a whole and that each of the claim limitations and the differences between the claims and the cited references must be considered. See *In re Gulack*, supra. When these limitations are considered, the references cited by the examiner are not properly combinable and do not suggest or disclose the limitations of Applicants' Claim 5. In view of these remarks, Applicants respectfully requests that the rejection of Claim 5 be withdrawn.

3. Claim 6 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of Applicants' invention. Claim 6 was noted to depend upon Claim 5, which was noted to depend upon itself. Applicants have now amended Claim 5 to depend upon Claim 2 and thus Claim 6 now has all of the limitations of amended Claim 5, its intermediate Claim 2 and its base claim, Claim 1. Considering this amendment, it is respectfully requested that the rejection of Claim 6 under 35 U.S.C. § 112, second paragraph, be withdrawn.

Claim 6 was also rejected under 35 U.S.C. § 103(a) as being unpatentable over a proposed combination of Adams et al (US 3,993,116) and Christiaens et al. (US 6,418,717) as applied to Claim 1 and Martin (5,249,993) and in further view of Johnson, Sr. (US 5,931,710, cited by Applicants) The Examiner thought that Adams et al. did not disclose a steering cylinder but that such a cylinder was thought to be disclosed by Johnson, Sr. and that it would be obvious to a person of ordinary skill in the art at the time the invention was made to form the device of Adams et al with a steering cylinder as taught by Johnson, Sr. for improved steering action.

Applicants respectfully suggest that all of the limitations of Claim 6 must be

considered and that this claims, as amended, is not suggested by the references cited. As previously noted, it would not be proper for the combination of Adams et al and Christiaens et al. to serve as 35 U.S.C. § 103(a) references to render the base claim and the intermediate claims of Claim 6 unpatentable. Consequently, they do not form a proper basis for combination with Martin or with Johnson, Sr. Further, as previously noted, it would be incorrect to focus the §103 inquiry on a particular limitation or on the “gist” of the invention relative to cited art. The differences between the Claim 6 and the cited references must be considered. See *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983). When these limitations are considered, the cited references do not suggest or disclose the limitations of Applicants’ claims. Considering the foregoing, it is respectfully requested that the rejection of Claim 6 be withdrawn.

4. Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over a proposed combination of Adams et al (US 3,993,116) and Christiaens et al. (US 6,418,717) as applied to Claim 1 and in further view of Johnson, Sr. (US 5,931,710, cited by Applicants). Adams et al. did not disclose a steering cylinder but that such a cylinder was thought to be disclosed by Johnson, Sr. and that it would be obvious to a person of ordinary skill in the art at the time the invention was made to form the device of Adams et al with a steering cylinder as taught by Johnson, Sr. for improved steering action.

Applicants respectfully suggest that all of the limitations of Claim 14 must be considered and that this claims, as amended, is not suggested by the references cited.

As previously noted, it would not be proper for the combination of Adams et al and Christiaens et al. to serve as 35 U.S.C. § 103(a) references to render the base claim and the intermediate claims of Claim 14 unpatentable. Consequently, they do not form a proper basis for combination with Martin or with Johnson, Sr. Further, as previously noted, it would be incorrect to focus the §103 inquiry on a particular limitation or on the “gist” of the invention relative to cited art. The differences between the Claim 14 and the cited references must be considered. See *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983). When these limitations are considered, the cited references do not suggest or disclose the limitations of Applicants’ claims. Considering the foregoing, it is respectfully requested that the rejection of Claim 14 be withdrawn.

5. Claim 15 was rejected under 35 U.S.C. § 103(a) as being unpatentable over a proposed combination of Adams et al (US 3,993,116) and Christiaens et al. (US 6,418,717) and Johnson, Sr. (US 5,931,710, cited by Applicants) as applied to Claim 14 and in further view of Martin (5,249,993). Martin was thought to disclose a weedless propeller, which was not disclosed in Adams et al. The Examiner thought that it would be obvious to a person of ordinary skill in the art at the time the invention was made to form the propeller of Adams et al as a weedless propeller to prevent stalling.

Applicants’ respectfully suggest that all of the limitations of claim 15 must be considered and that, for the reasons noted above the cited references are not properly combinable under 35 U.S.C. § 103(a). Consequently, Adams et al in view of

Christiaens et al. or Johnson, Sr. does not suggest or teach all of the limitations of claim 15. It is also suggested that it would be incorrect to focus the §103 inquiry on a particular limitation or on the “gist” of the invention relative to prior art. The claims must be read as a whole and that each of the claim limitations and the differences between the claims and the cited references must be considered. See *In re Gulack*, supra. When these limitations are considered, the references cited by the examiner are not properly combinable and do not suggest or disclose the limitations of Applicants’ Claim 15. In view of these remarks, Applicants respectfully requests that the rejection of Claim 15 be withdrawn.

6. Claims 7 and 16 – 18 were objected to as being dependent upon a rejected claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response Applicants respectfully suggest that in view of the arguments and remarks made herein above, claims 7 and 16-18 are allowable as rewritten and respectfully requests that the objection to these claims be withdrawn.

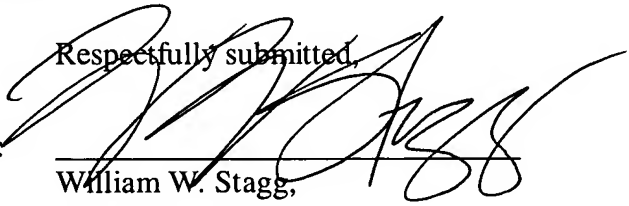
Claims 7 and 16 – 18 were objected to as being dependant upon a rejected base claim, but were thought by the Examiner to be allowable if rewritten in independent form including all of the limitations of the base claim an any intervening claims. Applicant has amended claim 7 to present it in independent form. The amendment includes the limitations of its previous base claim, Claim 1, and its previous intervening claims, Claims 2 and 3. Claim 16 has been rewritten in independent form to include all of the limitations of is previous base claim, claim 10, and it previous

intervening claims, Claims 11, 12, 14, and 15. Claims 17 and 18 now depend upon amended Claim 16 and thus include all of its limitations. It is respectfully suggested that Claim 7 and Claims 16 – 18 are now in condition for allowance.

7. Applicants respectfully request that this amendment be entered into the record, and after consideration by the Examiner, that each of the currently pending claims be allowed. If the Office disagrees with any of these remarks, or if other issues arise that may present an obstacle to allowance, the undersigned would welcome a telephone call to discuss such matters before further action is taken. Otherwise, Applicants respectfully requests that this case be allowed and that the application with the claims, as amended herein, be passed to issuance.

Respectfully submitted,

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